UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,310	12/12/2003	Tomohiro Shinoda	LIL-0002	9083

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EXAMINER
DHILLON, MANJOT K

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
12/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/733,310	SHINODA, TOMOHIRO
	Examiner	Art Unit	
	Malina K. Dhillon	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-7 and 9-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-7 and 9-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>05 February 2007</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is in response to applicant's response filed on November 10,

2007. Applicant amends claims 1, 3, 5-7, 9-11, adds claims 12-18 and responds to

rejections. Claims 1, 3, 5-7, 9-11, and 12-18 are pending.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

      1.   Determining the scope and contents of the prior art.
      2.   Ascertaining the differences between the prior art and the claims at issue.
      3.   Resolving the level of ordinary skill in the pertinent art.
      4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

3.   Claims 1, 3, 5-7, and 9-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Muroi (US 2002/0052238) in view of Nakamura (US 6468162).

4.   Concerning claims 1, 7, and 11, Muroi teaches a gaming machine comprising

three slots into which two or three trading cards can be inserted, each trading card

storing a set of character data and/or a data reading unit for reading character data from

at least two inserted trading cards, each trading card storing a set of character data

[0018/0022]; a card reader which reads character data from the inserted trading cards

[claim 1, lines 13-17]. Muroi discloses a controller [11: CPU, which functions as a

controller] which executes a predetermined computer program [pg. 5, right col., claim

8, lines 1-4], the controller being connected to the card reader and the payout device

[Fig. 1: the CPU is connected to the reader/writer through the data/address bus

(1K) and the transmission/reception interface, the payout device is the card

writer]; wherein the controller causes the card reader to read the character data [claim

8, lines 1-7], an advancing unit/device for advancing a game based on the read

character data [0018/0024]; a combining unit/device for combining at least two sets of

character data when a first predetermined condition is satisfied in the advanced game

[0006/0024/0032]. Two sets of character data are a new fighting outfit combined with

an old character. The predetermined condition is the round of the game. Nakamura

also teaches combining at least two sets of character data [column 10, lines 10-23].

Muroi teaches a determining unit/device for determining at least one set of character

data of a reward trading card based on the combined character data [claim 8, lines 11-

14; 0006/0018/0032]; a payout unit for paying out the reward trading card which stores

the determine set of character data [0039/0040; claim 8, lines 16-18; claim 4, lines 5-

9]. Muroi does not specifically disclose a payout; however the reward card obtains

payout via game data being written on the card. Further, Nakamura teaches the

characters data is paid out [column 10, lines 40-50].

Concerning claim 3, Muroi teaches the payout unit that includes writing unit for writing the determine set of character data in the reward trading card **[0039/0040; claim 8, lines 16-18; claim 4, lines 5-9]**. Muroi does not specifically disclose a payout; however the reward card obtains payout via game data being written on the card. Further, Nakamura teaches the characters data is paid out **[column 10, lines 40-50]**.

Concerning claim 5, Nakamura discloses the set of character data, which includes capability and attribute values **[col. 6, lines 17-25]**.

Concerning claim 6, Nakamura further discloses the payout unit **[col. 13, lines 18-19]** that includes printing unit for printing an image of the determined set of character data on a surface of the reward trading card **[col.13, lines 6-19]**.

Concerning claim 9, Muroi discloses a method for controlling a gaming machine comprising steps of: reading character data from two inserted trading cards, each trading card storing a set of character data **[claim 8, lines 5-7; 0018/0022]**; an advancing unit/device for advancing a game based on the read character data **[0018/0024]**; receiving an instruction of combining the character data, when a first prescribed condition is satisfied in the advanced game **[0006/0032]**; combining at least two sets of character data in response to the instructions **[0006/0024/0032]**. Two sets of character data are a new fighting outfit combined with an old character. The predetermined condition is the round of the game. Nakamura also teaches combining at least two sets of character data **[column 10, lines 10-23]**. Muroi teaches determining at least one set of character data of a reward trading card based on the combined character data **[0006/0032; claim 8, lines 11-14]**; and writing the set of

updated character data to the reward trading card **[claim 8, lines 16-18; claim 4, lines 5-9; 0006/0032]**. During the course of game play, the two sets of read character data are combined.

Concerning claim 10, Muroi discloses the method for controlling the gaming machine further comprising steps of: changing the character data based on the results of the game **[claim 8, claim 4, para. 0006 and para. 0032]**.

Concerning claim 12, Nakamura teaches comprising a changing unit for changing a number of combining set and a number of determining set **[column 10, lines 1-22]** in response to proceedings of the game. Muroi teaches the values and attributes written in the transponder vary by proceedings of the game **[0024]**.

Concerning claim 13, Muroi teaches a generating unit for generating a set of character data when a second predetermined condition is satisfied in the advanced game **[0006/0018/0024/0032]**. A second predetermined condition could be a third round of play.

Concerning claim 14, Nakamura teaches the combining unit combines the entirety of the read character data, and the determining unit determines the entirety of the rewarded character data based on the combined character data **[column 10, lines 1-22]**.

Concerning claim 15, Nakamura teaches the combining unit combines a part of the read character data, and the determining unit determines the entirety of the rewarded character data based on the combined character data **[column 6, lines 11-29; column 10, lines 1-22]**.

Concerning claim 16, Nakamura teaches the combining unit combines the entirety of the read character data, and the determining unit determines a part of the rewarded character data based on the combined character data **[column 6, lines 11-29; column 10, lines 1-22]**.

Concerning claim 17, Nakamura teaches the combining unit combines a part of the read character data, and the determining unit determines a part of the rewarded character data based on the combined character data **[column 6, lines 11-29; column 10, lines 1-22]**.

Concerning claim 18, Muroi teaches further comprising an updating unit for updating the character data based on the results of the game **[0006/0032; claim 8, lines 11-14]**.

It would be obvious to combine the Muroi trading card game with the Nakamura trading card game because all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Response to Arguments

5.   Applicant's arguments, pages 7-9 of Remarks filed 11/5/07, with respect to the Nakamura and Muroi reference have been fully considered but they are not persuasive. The combination of the Nakamura and Muroi teach the **claimed** invention. In response

to applicant's arguments that Nakamura does not provide the game which advances based on the character firstly possessed by the player, and the inherent interest of trading cards which is to collect trading cards has no connection to the game which is based on the firstly character, it is noted that the features upon which applicant relies (i.e., "game which advances based on the character firstly possessed by the player" and "collect trading cards") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant states that Muroi does not teach the combined character data of at least two characters data, is not paid out. However, examiner disagrees. To further explain, Muroi does not specifically disclose a payout; however the reward card obtains payout via game data being written on the card **[0039/0040; claim 8, lines 16-18; claim 4, lines 5-9]**. Further, Nakamura teaches the characters data is paid out **[column 10, lines 40-50]**.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the
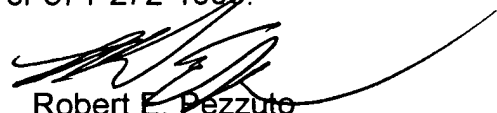
shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Malina K. Dhillon whose telephone number is (571) 270-

1297. The examiner can normally be reached on Mon. - Thurs., 7 AM - 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bob Pezzuto can be reached on (571) 272-6996. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert E. Pezzuto
Malina Dhillon   Supervisory Patent Examiner
12/11/07   Art Unit 3714